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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,014	07/13/2001	Thomas R. Spadaro	63134/P026US/10400589	2497
29053 7590 03/22/2007 DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			EXAMINER MEHRA, INDER P	
			ART UNIT 2617	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 03/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/905,014	<b>Applicant(s)</b> SPADARO ET AL.	
	<b>Examiner</b> Inder P. Mehra	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to Amendment dated 2/9/07. Based on this amendment, claim 1-53 are amended and claims 54-58 are added anew. Claims 1-58 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Claim Objections***

3. Claim 55 is objected to because of the following informalities:  
  
Claim 55 is identical to claim 9. Both of them depend from claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 2617

Claims 1 recites "switching means operable under control of said programmable control computer" is not supported by specifications, refer to specification page 3 line 1-5.

Specification discloses, "**the programming for the computer is not all performed by the computer at the site.** The system of the present invention distributes the processing to remote locations over an intranet or internet network". Similar problem exists in claims 12, 26 and 31.

Appropriate correction/clarification is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 4, 6-7, 12-17, 23, 26-27, 32-33, 36, 41-43, 47-48, and 52-53, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung et al** (US Patent Application No. 2003/0133558), hereinafter, Kung in view of **Gainsboro** (US Patent Application No. 2002/0071537).

For claims 1, 6, 12, 17, 26, Kung discloses "a controlled public telephone communications system, (The IP central station may be configured to store various control and system information such as location, address, and/or configurations of one or more broadband

Art Unit: 2617

residential gateways 300, as well as other routing and call set-up information, refer to paragraph 0038; configured to manage voice information transfers---, refer to paragraph 0038); comprising,

- a plurality of telephones at a given site (The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, refer to paragraph 0026);
- a programmable control computer (programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract), routing, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, (paragraph 35, 39 and 63), and the controlling usage of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);
- **As recited by claim 26, a Voice over Internet Protocol (VoIP) gateway for transmitting signals from said telephones into data packets transmitted over----- said control computer, (analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028; further, discloses, “the IP central station 200 may also include, for example, one or more of the following gateways:--- a voice gateway (VG) 232, and/or a multimedia gateway (MG) 230. The IP central station 200 may utilize one or more of these gateways to provide centralized**

**system intelligence and control of voice and/or data IP packets, refer to paragraph 0045 and VOIP telephony refer to paragraph 0041).); and**

- **switching means operable under control of said programmable computer for selectively connecting said telephone instruments with said Voice over Internet Protocol network (VOIP) network , wherein said telephones are connected to said public switched telephone network only under control of said programmable control computer, (Kung discloses, “programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055; “The central router 210 provides for example Ethernet switching and aggregate traffic between servers, gateways and the IP network 120 (Gateway is connected to various telephones, see fig. 1), and/or ATM network 185 backbone, refer to paragraph 0044); and further discloses analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028, 142, 144 and 120 in fig. 1));**
- **a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals external to said prison facility, (Alternatively, the user may use system memory in IP central (processor) and buffer data remotely, refer to paragraph 0093).**
- **an offsite public switched telephone network, as recited by claims 6, and 17, (160 in fig. 1, 2);**

Kung does not disclose explicitly “restricting usage”---“by

Art Unit: 2617

particular individuals" (**as recited in claim 26**). This limitation is disclosed by Gainsboro, explicitly, as follows:

Gainsboro discloses **"It would be highly desirable to provide an institutional telephone system that automatically prohibits inmates from attempting to call certain outside persons", refer to paragraphs 0006; further discloses "revoke an inmate's calling privileges", refer to paragraphs 0007 and 0014.**

It would have been obvious to the person of ordinary skill in the art at the time of the invention "restricting usage"---"by particular individuals". This capability can be implemented by combining "institutional telephone system", as taught by Gainsboro into Kung's "IP central station". The motivation for using this capability is to mitigate harassment problem. The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, various existing systems (legacy systems) such as the public switched telephone network (PSTN), ATM networks, the Internet, signaling networks, as well as other systems, refer to Kung's paragraph 0026).

For claims 2, 4, 13, and 16, Kung discloses "2. (Original) "wherein programming for said programmable control computer is distributed to at least one remote locations over said VoIP network (Kung discloses, **"distributed processing controller 306 which may be a microprocessor and/or one or more interconnected distributed processing modules for controlling the broadband residential gateway 300, refer to paragraph 0081).** Further, Kung

Art Unit: 2617

discloses Ethernet connection , **as recited by claim 13**, (interface or port connection), refer to paragraph 0027.

For claims 7, and 15, Kung discloses “wherein said off site switched telephone network is a Private Branch Exchange”(PBX 146 in fig. 1); and “a data exchange network interconnecting said sites over said Ethernet network”, **as recited by claim 15**, refer to PBX 146 in fig. 1 and paragraph 0027 for Ethernet LAN. .

For claim 14, Kung discloses “a plurality of said sites; said sites being interconnected over said Ethernet network, refer to LAN which is Ethernet based, refer to paragraph 0027.

For claims 23 and 27, wherein said VOIP gateway includes voice compression and packetization, **as recited by claims 23, and 27**, refer to Kung ‘558’s paragraph 0066 and 0080.

For claims ,32-33, 36, 41-43, 47-48 and 52-53, Kung discloses A call processing system for use in processing calls, (The IP central station may be configured to store various control and system information such as location, address, and/or configurations of one or more broadband residential gateways 300, as well as other routing and call set-up information, refer to paragraph 0038); said system comprising, :

- a plurality of telephone terminals (These voice networks are referred to as a public switched telephone network (PSTN) or plain old telephone service (POTS), refer to paragraph 0003; Referring to FIG. 1, an exemplary embodiment of a broadband



network 1. The broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, refer to paragraph 0026);

- a voice over Internet protocol (VoIP) gateway coupled to said plurality of telephone terminals and disposed locally with respect thereto, said VoIP gateway providing a digital data network interface providing digital communication of voice signals associated with one or more of said plurality of telephone terminals with user terminals, **as recited by claims 32 and 43**, (Refer to “gateway (BRG) 300.

Although the broadband residential gateway is preferably disposed in a residence for many aspects of the invention, in exemplary embodiments, it may also be disposed in a **business or other location**, see **paragraph 0027**. “Broadband residential gateway 300 may be connected to the remainder of the broadband network 1 using any suitable mechanism such as a **gateway directly into an IP network**”, see **paragraph 0079**).

- a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals, **as recited by claim 32**, (Alternatively, the user may use system memory in IP central (processor) and buffer data remotely, refer to paragraph 0093).
- a programmable control computer (programming messages and/or computer data between the various devices, **as recited by claim 41 also**, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and

Art Unit: 2617

abstract), routing, **as recited by claims 33 and 48 also**, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, **as recited by claims 36 and 47**, (paragraph 35, 39 and 63), and the control of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);

- terminals ---via public switched telephone network, **as recited by claim 42 also**, (160 in fig. 1, 2);
- wherein said centralized system provides call monitoring with respect to said call, **as recited by claim 52**, (refer to Kung's reference: "The BRG 300 monitors whether the subscriber wants to connect to an incoming call or a call waiting on the queue at Step S750.
- **as recited by claim 53**, wherein said call processing system is a prison telephone system (refer to Kung, "Although the broadband residential gateway is preferably disposed in a residence for many aspects of the invention, in exemplary embodiments, it may also be disposed in a business or other location", see paragraph 0027).

It would have been obvious to the person of ordinary skill in the art at the time of the invention "“prison facility”". This capability can be implemented by combining "institutional telephone system", as taught by Gainsboro into Kung's "IP central station". The motivation for using this capability is to mitigate harassment problem and directs the computer control unit to prohibit similar calls in the future.

Art Unit: 2617

8. Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Gainsboro, as above, further, in view of **Cell Jr. (US Patent No. 6,876,647), hereinafter, Cell.**

For claims 3 and 22, Kung in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by Cell, as follows:

- wherein said programmable control computer further comprises a VoIP gateway for servicing and control of VoIP communications over said VoIP network (A machine readable storage, having stored thereon a computer program for streaming voice data, ---to perform the steps of: establishing a plurality of voice call connections with a voice over IP (VoIP) gateway), refer to claim 17 of Celi).

It would have been obvious to the person of ordinary skill in the art at the time of the invention to use programmable control computer further comprising a Voice gateway for servicing and control of Voice communications. This capability can be implemented by combining VOIP gateway into IP central station. The motivation for using VOIP gateway in IP central station is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

9. Claims 4 and 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung** in view of **Gainsboro**, as above, further, in view of **Vo et al (US Patent No. 6,795,444), hereinafter, Vo.**

Art Unit: 2617

For claims 4 and 5, Kung in view of Gainsboro discloses all the limitations of subject matter, including the limitation, **as recited by claim 4, (see page 6 of office action)**. Vo also discloses the limitations of claim 4, as follows:

- a plurality of said given sites (270 and 272); at least one programmable control computer (MCU 280) at each site; said sites being interconnected over said Voip network (108), **as recited by claim 4**, refer to fig. 2A.

Kung in view of Gainsboro does not disclose explicitly the following limitations of claim 5, which are disclosed by VO, as follows:

- a data exchange network interconnecting said sites, said telephone communications systems being integrated into said data exchange network, **as recited by claim 5**, (hubs/bridges 286A through 286D).

It would have been obvious to the person of ordinary skill in the art at the time the invention to use a plurality of said given sites (270 and 272); at least one programmable control computer (MCU 280) at each site; said sites being interconnected over said Voip network (108). This capability can be implemented by combining programmable computer in each station. The motivation for using VOIP is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

10. Claims 8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable **Kung'558** in view of **Gainsboro**, further, in view of **Kung et al** (US Patent No. 6,816,469), hereinafter, **Kung'469**

Art Unit: 2617

For claims 8 and 18, Kung'558 discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by a Gainsboro, as follows:

**“imposing a three way call restriction”, (Gainsboro discloses “It would be highly desirable to provide a method ---for allowing a recipient of an undesired call from an inmate to easily and automatically prohibit all future calls from that particular inmate, refer to Gainsboro’s paragraph 0006).**

It would have been obvious to the person of ordinary skill in the art at the time the invention to use a imposing a three way call restriction. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a voice call connection and receiving audio data from a network source.

For claim 19, Kung'558 disclose the following limitations:

- wherein said VOIP gateway (300 in fig. 1) is disposed between said telephone and said VOIP network (refer to paragraph 0041); and a second VOIP gateway (230 in fig. 2) between said VOIP network and said offsite public switched telephone network, refer to fig. 2 and paragraph 0041).

11. Claims 9, 21, 35, 49 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung'558 in view of Gainsboro**, as above, further in view of **Kung et al** (US Patent No. 6,687,360), hereinafter, Kung''360.

Art Unit: 2617

For claims 9, 21, 35, 49 and 55-58, Kung'558 in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which is disclosed by Kung'360, as follows:

- wherein said programmable control computer comprises: a system responsive to personal identification numbers (PIN keyed into said telephones for authorizing stored permitted telephone usage associated with individual PIN numbers **(the subscriber dials a toll-free number for location registration using either a PIN or some other personal information that uniquely identifies the subscriber, refer to col. 29 lines 45-60.**

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of a system responsive to personal identification numbers (PIN keyed into said telephones. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to identify the caller and establish a voice call connection and receiving audio data from a network source.

12. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung'558, and in view of Gainsboro, as above**

For claims 10 and 11, Kung'558 discloses the following limitation:

- wherein said gateway is an internal gateway, **as recited by claim 10;** and wherein said gateway is an external gateway shared with other Voice devices outside of said control computer, **as recited by claim 11, (Kung '558 discloses “a gateway such as the head-end hub (HEH) 115. The head-end hub 115 may be variously**

**configured to provide various services and/or interconnections with the rest of the broadband network 1", refer to paragraph 0029).**

13. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung558**, in view of **Gainsboro** and **Cell Jr. (US Patent No. 6,876,647)**, hereinafter, **Cell**, further, in view of, **Weitz (US Patent No. 6,445,682)** .

For claim 28, Kung558 and Cell disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by Weitz, as follows:

- wherein a second VOIP gateway includes decompression and depacketization, **as recited by claim 28**, refer to Weitz,'s col. 44 line 45 through col. 45 line 15.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of decompression and depacketization . This capability can be implemented by combining into IP central station. The motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

For claim 29, Kung'558 discloses, " VOIP gateway includes an Ethernet network interface, **as recited by claim 29**, refer to Kung's paragraph 0027.

14. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung558 in view of Gainsboro, Cell, and Weitz**, as above, further, in view of **Pogossiants et al (US Patent Application No. 2001/0028649)**, hereinafter, '649.

For claim 30, Kung558 disclose all the limitations of subject matter with the exception of

Art Unit: 2617

the following limitation, which is disclosed by Gainsboro, as follows:

**\* imposing a third party call restriction”, (Gainsboro discloses “It would be highly desirable to provide a method ---for allowing a recipient of an undesired call from an inmate to easily and automatically prohibit all future calls from that particular inmate, refer to Gainsboro’s paragraph 0006).**

Kung 558, Gainsboro, Cell and Wertz disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by ‘649, as follows:

- a third party call detection system; and a public switched telephone network, said third party call detection system being between said second VOIP gateway and said public switched telephone network, refer to fig. 6, paragraphs 0025 and 0090).

It would have been obvious to the person of ordinary skill in the art at the time the invention to use the capability of a third party call detection system; and a public switched telephone network, said third party call detection system being between said second VOIP gateway and said public switched telephone network. This capability can be implemented by combining it into IP central station,. The motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.

15. Claims 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable Kung’558 , over Gainsboro, as above, further, in view of **Pogossiants et al** (US Patent Application No. 2001/0028649), hereinafter, ‘649.



Art Unit: 2617

For claims 20 and 30, Kung'558, in view of Gainsboro disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by'649, as follows:

- wherein said three-way call detection is performed between said second VOIP gateway (PBX telephony switch, refer to paragraph 0025) and said public switched telephone network 617, refer to fig. 6, paragraphs 0025 and 0090).

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of third party call detection. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephone calling.

16. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung'558 in view of Gainsboro, as above , further, in view of **Weitz** (US Patent No. 6,445,682)

For claims 24 and 25, Kung'558 in view of Gainsboro disclose all the limitations of subject matter with the exception of the following limitation, which is disclosed by Weitz, as follows:

- wherein said second Voce gateway includes decompression and depacketization, refer to col. 44 line 45 through col. 45 line 15.
- wherein said VOIP gateway includes an Ethernet network interface, refer to col. 44 line 45 through col. 45 line 15.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of Voce gateway includes decompression and depacketization and

Art Unit: 2617

VOIP gateway includes an Ethernet network interface. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

17. Claims 34, 37, 39, 44-45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung'558, over **Gainsboro, as above, further, in view of Gainsboro** (US Patent No. 6,611,583).

For claims 34, 37, 39, 44-45 and 50, Kung'558 in view of Gainsboro '537 discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Gainsboro''583, as follows:

- wherein said call control provided by said processor-based system comprises telephone usage restriction checking, **as recited by claim 34**, (refer to col. 7 lines 17-42.
- wherein said call control provided by said processor-based system comprises call monitoring, **as recited by claim 37**, (refer to col. 7 lines 17-42.
- wherein said call fraud detection comprises three-way call detection, **as recited by claims 39, 44-45, and 50**, (refer to col. 6 line 53-col. 7 line 15. .

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of call control provided by said processor-based system comprises telephone usage restriction checking, monitoring and three way call detection. This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

Art Unit: 2617

18. Claims 38-39 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung**'558 , in view of Gainsboro, further, in view of **Peel et al** (US Patent No. 5,907,602).

For claims 38, 39 and 51, Kung'558 in view of Gainsboro discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Peel , as follows:

- wherein said call control provided by said processor-based system comprises call fraud detection, **as recited by claim 38**, refer to col. 33 lines 14 –24.
- wherein said call fraud detection comprises three-way call detection **as recited by claim 39 and 51**, refer to col. 33 lines 14 –24.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of call control provided by said processor-based system comprises call fraud detection, . This capability can be implemented by combining it in IP central station, as taught by Kung'558. The motivation for using VOIP is to establish a VOIP telephoning calling.

19. Claims 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kung et al**, hereinafter, Kung'558 , in view of **Ziegler et al** (US Patent Application No.2003/0023714), hereinafter, Zeigler.

For claims 40 and 46, Kung'558 discloses all the limitations of subject matter with the exception of the following limitation, which are disclosed by Zeigler, as follows:

- wherein said processor-based system provides real time call recording, refer to paragraph 0013.

It would have been obvious to the person of ordinary skill in the art at the time the invention to use capability of processor-based system provides real time call recording. This capability can be implemented by combining it in IP central station, as taught by Kung '558. The motivation for using VOIP is to establish a VOIP telephoning calling.

*Allowable Subject Matter*

20. Claim 54 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

21. Applicant's arguments filed 2/9/2007 have been fully considered but they are not persuasive.

Applicant argues, “, there is no motivation to solve "harassment problems" in Kung '558. Therefore, there is no motivation to add elements of Gainsboro into Kung '558 to address the afore mentioned problems. The Examiner has also stated that call restriction capability can be implemented by combining the institutional telephone system of Gainsboro with Kung '558's IP central station (200). Final Office Action, page 5. However, the mere fact that references can be combined or modified **does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990), cited in M.P.E.P. § 2143.01.**

Applicant, further, argues, “**Applicant respectfully disagrees with the proposition that elements of Gainsboro and Kung '558 can indeed be combined, as proposed by the Examiner.** Specifically, Kung's IP central station (200) interfaces with a packetized communication system via an IP network (120). Kung '558, Figure 1. Meanwhile, Gainsboro's computer or CCU (3) controls telephone

Art Unit: 2617

access in a public switched telephone network (PSTN) or plain old telephone service (POTS) environment via a trunk management unit or TMU (2) based upon DTMF tones captured by TMU (2). Gainsboro, paragraphs [0014]-[0016]; Figure 1. In contrast with Gainsboro's system, Kung's IP central station (200) does not interact with telephones, and it does not exchange messages with a trunk management unit, such as Gainsboro's TMU (2). Kung '558, paragraphs [0042]-[0077]. Therefore, adding Gainsboro's CCU (3) into Kung '558's IP central station (200) would require a substantial reconstruction and redesign of the elements shown in Kung '558.

In addition, Applicant respectfully reminds the Examiner that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959), cited in M.P.E.P. § 21.43.01(VI). In this case, Kung '558 provides a communications system that allows the free exchange of telephone calls, messages, and the like. Kung '558, paragraphs [0026] and [0037]; Figure 1. In fact, Kung '558's operates to "expand[] the scope of traditional PSTN call waiting services by allowing a subscriber to be on one call and receive and place in a call queue, multiple [other] calls ...." Kung '558, paragraph [0011]. Clearly, Kung '558's main goal is to expand (not restrict) telephone calls being made. So, because the proposed combination of Gainsboro's telephone restrictions with Kung '558's system would change the principle of operation of Kung '558 the teachings of the applied references are not sufficient to render the claims obvious.

In response to applicant's argument that Kung '558 and Gainsboro prior art are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case,

Art Unit: 2617

- Kung'558 recites all of the limitations of independent claims, such as, "a programmable control computer (programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055, for switching (paragraphs 0040,0044), accessing (paragraph 0006 and abstract), routing, (paragraph 0037, 40, 44, and 57), timing (paragraph 0044, 48 and 67), billing, (paragraph 35, 39 and 63), and the controlling usage of said telephones (figs. 2 and 3 and paragraphs 27 and 55), said telephones (106, 108, 110 and PSTN) being connected to said computer (200 in fig. 4);
- **As recited by claim 26, a Voice over Internet Protocol (VoIP) gateway for transmitting signals from said telephones into data packets transmitted over----- said control computer, (analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028; further, discloses, "the IP central station 200 may also include, for example, one or more of the following gateways:--- a voice gateway (VG) 232, and/or a multimedia gateway (MG) 230. The IP central station 200 may utilize one or more of these gateways to provide centralized system intelligence and control of voice and/or data IP packets, refer to paragraph 0045 and VOIP telephony refer to paragraph 0041).); and**
- switching means operable under control of said programmable computer for selectively connecting said telephone instruments with said Voice over Internet Protocol network (VOIP) network , wherein said telephones are connected to said public switched telephone network only under control of said programmable control

- computer, (Kung discloses, “programming messages and/or computer data between the various devices, refer to paragraphs 0036, 0037, 0055; “The central router 210 provides for example Ethernet switching and aggregate traffic between servers, gateways and the IP network 120 (Gateway is connected to various telephones, see fig. 1), and/or ATM network 185 backbone, refer to paragraph 0044); and further discloses analog voice may be converted to digital data and packetized for transmission in an appropriate output protocol such as an Internet protocol (IP), refer to paragraph 0028, 142, 144 and 120 in fig. 1));
- a processor-based system coupled to said VoIP gateway and disposed remotely with thereto, said processor-based system providing call control for controlling communications between said plurality of telephone terminals and said user terminals external to said prison facility, (Alternatively, the user may use system memory in **IP central (processor) and buffer data remotely**, refer to paragraph 0093).
  - an offsite public switched telephone network, as recited by claims 6, and 17, (160 in fig. 1, 2);

In all independent claims 1, 12, 26, 32, the broadband network generally provides interconnection between a plurality of customer locations utilizing various interconnection architectures including Internet Protocol (IP) based network, various existing systems (legacy systems) such as the public switched telephone network (PSTN), ATM networks, the Internet, signaling networks, as well as other systems, refer to Kung’s paragraph 0026). Kung, therefore, is explicitly pertinent to the claimed limitations.

Art Unit: 2617

Applicant argues, "Therefore, although Kung '558's system may be deployed in "a business or other location," there is no indication that its system would be successfully implemented in a "prison facility."

In response, examiner states that "prison facility." Is nor claimed as such, in independent claims. If applicant prefers "prison facility" , then ishold be claimed that way.

Applicant argues, "The coupling of a control computer for restricting usage of telephones placing and/or receiving calls using a VoIP network as set forth in the claims has been found to provide unexpectedly improved operational properties. As set forth in detail in the Declaration of Robert L. Rae attached hereto, use of a control computer for restricting usage of telephones for calls using a VoIP network provides unexpected improvements with respect to numerous control features used in restricting telephone usage. Such evidence that the claimed invention yields unexpectedly improved properties is evidence of the non-obviousness of the claimed invention, see e.g., *In re Dillon*, 16 U.S.P.Q.2d 1897, 1902 (Fed. Cir. 1990).

In response to applicant's argument that **"The coupling of a control computer for restricting usage of telephones placing and/or receiving calls using a VoIP network as set forth in the claims has been found to provide unexpectedly improved operational properties"**., the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

**In light of above explanation, arguments by applicant are not persuasive.**

### *Conclusion*



Art Unit: 2617

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Inder P. Mehra whose telephone number is 571-272-3170. The examiner can normally be reached on Monday through Friday from 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Inder Pal Mehra 3/14/07*

Inder P Mehra  
Examiner  
Art Unit 2617

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER